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EXAMINER

CHEN, CHONGSHAN

ART UNIT

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2162

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/843,059	Applicant(s) DUTTA ET AL.	
	Examiner Chongshan Chen	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-10, 13-16 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 13-16 and 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to Amendment filed on July 29, 2005. Claims 1-4, 7-10, 13-16, 19-24 are pending.

Terminal Disclaimer

2. The terminal disclaimer filed on November 12, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 09/843,063 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 10, 13, 14 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 10, 13, 14 and 24 are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 21, lines 1-11, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., hard disk) and intangible embodiments (e.g., analog communication links). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional

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media. Carrier medium and transmission media would be not statutory but storage media would be statutory.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 7-8, 10, 13-16 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olah et al. (hereinafter "Olah"; US 6,446,119 B1) in view of Pavley et al. (hereinafter "Pavley", US 6,317,141 B1).

As per claim 1, Olah teaches a method for displaying, at a client, transient messages received over a network, the method comprising:

storing in a chronological list, independently of a user action, a plurality of different multimedia objects each containing at least one transient message when each multimedia object is initially rendered at the client (Olah, col. 4, lines 32-33, screen captures are executed and saved to a log, log stores data in an first in first out order, which is a chronological list).

Olah teaches displaying the captured screen images, but does not explicitly disclose displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering

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a given multimedia object. Pavley discloses displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object (Pavley, col. 2, lines 15-20, col. 11, lines 30-67, col. 13, lines 57-65, Pavley teaches creating a slide show for the captured screen images. A slide show such as Microsoft PowerPoint displays a list of multimedia objects and plays the list of multimedia objects in a forward and backward succession at a user configurable rate).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Olah by incorporating the Microsoft PowerPoint program as disclosed by Pavley. The motivation being to allow the user to use Microsoft PowerPoint to create a slide show for the images in the activity log of Olah and play the captured multimedia objects in a forward and backward succession at a rate specified by user. This is much convenient for the user because the user does not need to select and play the multimedia object one by one.

As per claim 2, Olah and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach each one of the plurality of different multimedia objects is at least one of an animated GIF multimedia object, a moving picture type multimedia object, a vector graphic multimedia object, and a static image multimedia object (Olah, col. 4, lines 32-35).

As per claim 3, Olah and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach storing at least one of the multimedia objects at the client (Olah, col. 5, lines 46-60).

As per claim 4, Olah and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach storing at least one of the multimedia objects at a server which is in communication over the network with the client (Olah, col. 5, line 61 – col. 6, line 16).

As per claim 7, Olah and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach the storing step occurs for a configurable duration of time (Olah, Olah, Fig. 2-3).

As per claim 8, Olah and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach storing at a server, which is communicatively connected over the network with the client, each of the multimedia objects in the chronological list as each multimedia object is initially rendered at the client (Olah, col. 4, lines 32-35, col. 5, line 61 – col. 6, line 4).

Claims 10, 13-16 and 19-20 are rejected on grounds corresponding to the reasons given above for claims 1-4 and 7-8.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olah et al. (hereinafter “Olah”, US 6,446,119 B1) in view of Pavley et al. (hereinafter “Pavley”, US 6,317,141 B1) and Bretschneider et al. (hereinafter “Bretschneider”, US 6,008,807).

As per claim 9, Olan discloses a method for displaying, at a client, transient messages received over a network, the method comprising:

storing, at a server which is communicatively connected over the network with the client, in a chronological list, independently of a user action, a plurality of different multimedia objects each containing at least one transient message when each multimedia object is initially rendered at the client (Olah, col. 4, lines 32-33, screen captures are executed and saved to a log, log stores data in an first in first out order, which is a chronological list, col. 5, line 61 – col. 6, line 32, the image capture program can be run from a server, monitor and capture multimedia objects/screen images for a target computer on the network, and store the multimedia objects at a server computer).

Olan does not explicitly disclose displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia objects.

Pavley teaches displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia objects (Pavley, col. 2, lines 15-20, col. 11, lines 30-67, col. 13, lines 57-65, Pavley teaches creating a slide show for the captured screen images. A slide show such as Microsoft PowerPoint displays a list of multimedia objects and plays the list of multimedia objects in a forward and backward succession at a user configurable rate).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Olah by incorporating the Microsoft PowerPoint program as disclosed by Pavley. The motivation being to allow the user to use Microsoft PowerPoint to create a slide show for the images in the activity log of Olah and play the captured multimedia objects in a forward and backward succession at a rate specified by user. This is much convenient for the user because the user does not need to select and play the multimedia object one by one.

The Olah and Pavley's combined references teaches the stored multimedia objects can be stored on a server and using Microsoft PowerPoint program to displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects, however, neither Olah nor Pavley explicitly discloses sending a next sequential given one of the different multimedia objects from the chronological list and a corresponding software unit to enable the multimedia object to be played in an area of a document allocated to the multimedia object in response to a selection of a replay button sent from the server displayed at the client in an area of a document allocated to the multimedia object. Bretschneider teaches sending a next sequential given one of the different multimedia objects from the chronological list and a corresponding software unit to enable the multimedia object to be played in an area of a document allocated to the multimedia object in response to a selection of a replay button sent from the server displayed at the client in an area of a document allocated to the multimedia object (Bretschneider, col. 1, lines 61-65, the user can download the slide presentation from the server (which is equivalent to the server sends the slide presentation to the client) and specifying a starting/ending position for the slide presentation, Fig. 9A, element 920 "From" and "To". The

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slide presentation is displayed in an area of a document allocated to the multimedia object, Fig.4, col. 6, lines 36-43). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Olah and Pavley's combined system by downloading the slide presentation from the server and displaying the slide presentation as disclosed by Bretschneider (Bretschneider, col. 1, lines 61-65, Fig. 9A, element 920, Fig. 4, col. 6, lines 36-43). The motivation being to store the multimedia objects in a server in order to save storage space in a local computer and use slide presentation to displayed the captured multimedia objects in sequence without the burden of selecting and displaying the captured multimedia object one by one.

8. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engle et al. (hereinafter "Engle", Pub. No.: US 2004/0024640 A1) in view of Moore et al. (hereinafter "Moore", Pub. No.: 2001/0039546 A1) and further in view of Pavley et al. (hereinafter "Pavley", US 6,317,141 B1).

As per claim 21, Engle discloses a method for redisplaying, at a client, at least one transient message displayed in a browser, the method comprising:

identifying a region associated with the at least one transient message (Engle, page 1, [0013]-[0014]);

clipping the region associated with the at least one transient message (Engle, page 1, [0013]-[0014], the browser can delete and replace the detected ad with another ad which inherently includes clipping the region associated with ad);

storing in a chronological list, independently of a user action, each transient message (Engle, page 2, [0020], “stored according to user defined criteria...” which inherently includes the user-defined option to store the captured advertisement in a chronological list).

Engle teaches capturing and storing the transient messages (ads), however, those transient messages (ads) are stored before they are rendered by the browser (Engle, page 2, [0020]).

Moore teaches capturing and storing the transient messages (ads) when each transient message is initially rendered by the browser (Moore, page 1, [0011]-[0013]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the advertisement capturing system of Engle by replacing the capturing module of Engle with the capturing module of Moore which stores the transient messages when the transient messages are initially rendered by the browser independent of a user action. The motivation being to provide an automatic system which displays and captures advertisement on the browser. This automatic system saves the user time for manually displaying and capturing the advertisement on the display.

Both Engle and Moore disclose replaying the captured advertisements (Engle, page 2, [0020], Moore, page 1, [0011]-[0013]). However, neither Engle nor Moore explicitly disclose displaying the chronological list with control buttons for enabling a subsequent rendering of the transient messages in a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given transient message.

Pavley teaches displaying the chronological list with control buttons for enabling a subsequent rendering of the transient messages in a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given transient message (Pavley, col. 2, lines 15-20, col. 11, lines 30-67, col. 13, lines 57-65, Pavley teaches creating a slide show for the captured screen images. A slide show such as Microsoft PowerPoint displays a list of multimedia objects and plays the list of multimedia objects in a forward and backward succession at a user configurable rate).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Engle and Moore's combined system by incorporating the Microsoft PowerPoint program as disclosed by Pavley. The motivation being to allow the user to use Microsoft PowerPoint to create a slide show for the captured advertisements and play the captured advertisements in a forward and backward succession at a rate specified by user. This is much convenient for the user because the user does not need to select and play the advertisements one by one.

As per claim 22, Engle, Moore and Pavley teach all the claimed subject matters as discussed in claim 21, and further teach comprising associating a separate identifier for each stored transient message; and enabling a use of the identifier for the user selection (Engle, page 2, [0024]).

Claims 23 and 24 are rejected on grounds corresponding to the reasons given above for claim 21.

Response to Arguments

9. Applicant's arguments filed on July 29, 2005 have been fully considered but they are not persuasive.

10. As per applicant's arguments regarding Olah does not teach storing multimedia objects have been considered but are not persuasive. Olah teaches capturing screen images and storing the captured screen images in a log (Olah, col. 4, lines 32-35). The screen images are the multimedia objects. Therefore, the arguments are not persuasive.

11. As per applicant's arguments regarding the combination of Olah and Pavley does not teach displaying a chronological list with control buttons for subsequently rendering of the stored multimedia objects have been considered but are not persuasive. Pavley teaches the user may import the images and video directly into a presentation program, such as Microsoft PowerPoint™ (Pavley, col. 2, lines 15-17), and create a slide show (Pavley, col. 8, lines 53-64). Microsoft PowerPoint displays a list of captured and stored image objects and control buttons for replaying the images in a slide show (Please see the Figure 1 below). Figure 1 shows Microsoft PowerPoint program with control button to play the list of captured and stored images in a slide show. In the left panel of the Figure 1, Microsoft PowerPoint displays the list of captured and stored image objects. Since Olah and Engle teach capturing and storing images in a chronological list and Pavley teaches importing the images into Microsoft PowerPoint and creating a slide show, Microsoft PowerPoint creates a slide show with the images in chronological list and displays the chronological list in the left panel of Figure 1. Microsoft slide show displays the chronological list of captured and stored images in forward succession at a

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user configurable rate (Pavley, col. 15, line 65 – col. 16, line 2). The combination of Olan and Pavley teaches the claimed limitation. The arguments are not persuasive.

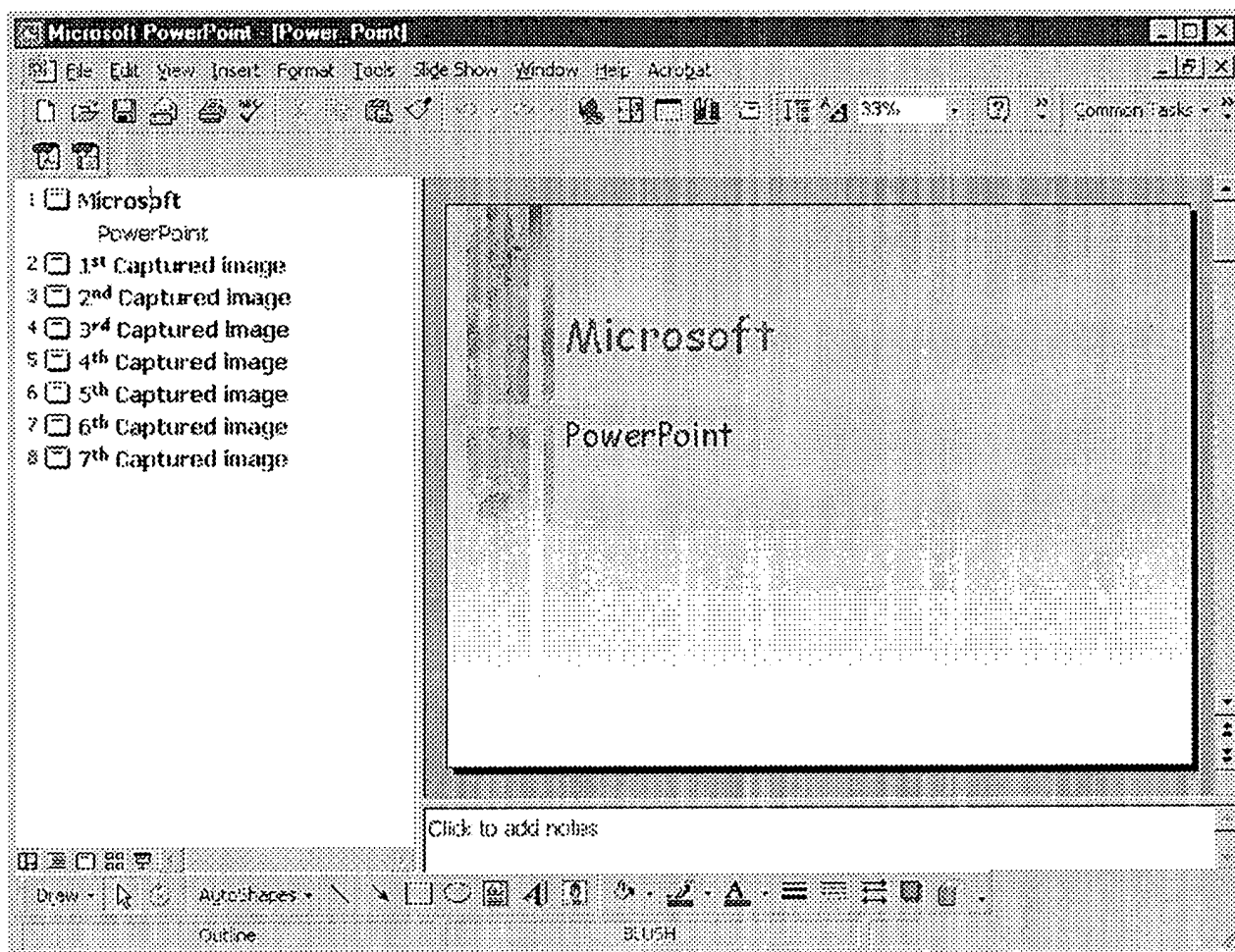


Fig. 1

12. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is (571) 272-4031. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chongshan Chen
October 14, 2005


JEAN M. CORRIELUS
PRIMARY EXAMINER